

Application No.: 09/812,558
Art Unit: 3628

Attorney Docket No. 18433.00
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REMARKS

By the present amendment, Applicants propose to amend Claim 18. Upon entry of the proposed amendment, independent Claims 1, 11 and 15, with Claims 2-10, 12-14, and 16-20, respectively, depending therefrom will remain for consideration.

Applicant appreciates the courtesies extended to Applicant's representative during the personal interview held January 13, 2003. The present response summarizes the substance of the interview. At the interview arguments were advanced that independent Claims 1 and 11 are not anticipated by Yu et al. (U.S. Patent No. 5,688,063), that independent Claims 1 and 11 are not unpatentable over Miceli (U.S. Patent No. 5,140,840) in view of Gong-Hwa (U.S. Patent No. 5,622,062), and that independent Claim 15 is not unpatentable over Miceli in view of Gong-Hwa and further in view of Erickson (U.S. Patent No. 4,781,036). The Examiner indicated that no agreement was reached, but that Applicants' arguments would be fully considered upon submission of a response.

The Examiner objected to Claim 18 because of an informality, viz., that "mixed" should be corrected to read --fixed--. Applicants have so amended Claim 18 to correct the typographical error.

In the Final Office Action the Examiner rejected Claims 1-3, 5, 7-11, and 13 under 35 U.S.C. § 102(b) as being anticipated by Yu et al. Claims 1, 4 and 11 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miceli in view of Gong-Hwa. Claims 6 and 12-17 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miceli in view of Gong-Hwa and further in view of Erickson. Claims 18-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miceli in view of Gong-Hwa

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and Erickson and further in view of Moody (U.S. Patent No. 5,140,840). Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Miceli in view of Gong-Hwa and Erickson and further in view of Riley (U.S. Patent No. 5,048,310).

Applicant hereby traverses the rejections under 35 U.S.C. § 102(b) and 35 U.S.C. § 103 (a). Applicant will advance arguments hereinbelow to illustrate the manner in which the presently claimed invention is patentably distinguishable from the cited and applied prior art. Reconsideration of the present application is respectfully requested.

With respect to the rejection of independent Claims 1 and 11 under 35 U.S.C. § 102(b), Applicant first notes that the reference must show every element of the claimed invention identically. *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1 USPQ2d 1081 (Fed. Cir. 1986), *Akzo N.V. v. United States Intl. Trade Commission*, 808 F.2d 1471, 1 USPQ2d 1241 (Fed. Cir. 1986). Not only must every element claimed be shown in the prior art reference, but every claimed limitation of each of the elements must be shown; otherwise, the only possible rejection is for obviousness under 35 U.S.C. § 103. *Atlas Powder Co. v. E.I. du Pont de Nemours & Co.*, 750 F.2d 1569, 224 USPQ 409 (Fed. Cir. 1984), *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985).

In rejecting Claims 1 and 11 as being anticipated by Yu et al., the Examiner claims that Yu shows "...attachment means (free end of 92) for securing the vibrating body jewelry item to a body part of a user..." on page 2 of the Office Action. The first full paragraph on page 4 further amplifies the Examiner's position as follows:

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As to claim 13, Yu discloses said attachment means includes a post 92 inserted through a wearer's body part, and a keeper (free end of 92) to retain said item on the pierced body part. These limitations are intended use and functional and hold little patentable weight. The fact that the attachment means is inserted through a pierced body part or retained on a pierced body part does not further define the structure of the invention.

Applicants note that the invention described in the Yu patent is not an item of jewelry designed to be inserted through a pierced body part, but a small massage device built into a writing apparatus, viz., a pen, and that reference number 92 refers to a clip that, from all appearances, is of a conventional type commonly found on pens. The free end of 92 is a small bead which, together with the spring clip 92, usually operates to grip a piece of clothing or a pen case to secure the pen in a shirt pocket when not in use. Nowhere in Yu is it claimed that such a pen clip 92 can be inserted through a pierced body part and retained therein by the bead at the free end, nor are Applicants aware of anyone who has ever used a similar pen clip 92 for such a purpose.

Claims 1 and 11 as amended recite, in relevant part, "attachment means for securing the vibrating jewelry item to a body part of a user..." This claim element is clearly formatted as a means plus function element, invoking the provisions of 35 U.S.C. § 112, paragraph 6. In interpreting means plus function language in claims, the Courts first determine whether the provisions of § 112, ¶6 have been invoked, i.e., that the element is described as a means for performing a function without reciting the structure of the means. The Courts then proceed to determine (1) the function to be performed; and (2) the structure of the means described in the specification and structural equivalents thereof. *Texas Digital Sys., Inc. v.*

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Telegenix, Inc., 308 F.3d 1193, 64 USPQ2d 1812 (Fed. Cir. 2002), *cert. denied*, 123 S. Ct. 2230 (2003).

In interpreting a means plus function clause for purposes of 35 U.S.C. § 102(b) and § 103(a), prior to 1994 the PTO would interpret a means plus function clause broadly to encompass any element which performed the same function, regardless of its structure. However, after the Federal Circuit decision in *In re Donaldson*, 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), the PTO has agreed that the Examiner must show not only that the function of the means clause reads literally on an element in the prior art, but also that the prior art element is structurally the same as, or is the “equivalent” of, the element in the application which supports the means clause, as required by 35 U.S.C. § 112, last paragraph (see MPEP 2181). MPEP 2184 sets forth several factors that must be considered in determining equivalents under 35 U.S.C. § 112, 6th paragraph, including, in relevant part, (1) whether the prior art element performs the function specified in the claim in substantially the same way; (2) whether a person of ordinary skill in the art would have recognized the interchangeability of the element shown in the prior art for the corresponding element shown in the application; and (3) whether the prior art element is a structural equivalent of the corresponding element disclosed in the specification being examined.

As discussed above, the clip 92 shown in Yu et al. is a conventional pen clip used to attach a pen to a shirt pocket or pen case when not in use, the bead at the free end of the clip 92 being used to grip the pocket or pen case. The attachment means recited in claims 1 and 11 is for attaching the vibrating body jewelry to “a body part of a user.” Consequently, the clip 92 shown in the Yu patent does not perform the

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same function recited by the attachment means of Claims 1 and 11 of the present invention. MPEP 2184 states, in the subsection headed "Factors to be Considered in Deciding Equivalence", that "...unless an element performs the identical function specified in the claim, it cannot be an equivalent for the purposes of 35 U.S.C. 112, sixth paragraph...", citing *Pennwalt Corp. v. Durand-Wayland, Inc.*, 833 F.2d 931, 4 USPQ2d 1737 (Fed. Cir. 1987), *cert. denied* 484 U.S. 961 (1988). For this reason, the Yu patent does not show the attachment means element, and is therefore not a proper 35 U.S.C. § 102(b) reference.

In addition, the attachment means described in the specification include a keeper formed by a large diameter ball **24** attached to the end of the post (Fig. 2), a keeper formed by a ring **24'** attached to the end of the post (Fig. 3), and a clamp or clasp **28** having opposable jaws attached to the end of the post (Fig. 4). Applicants respectfully submit that those skilled in the jewelry making arts would not recognize the bead at the free end of clip **92** as an equivalent substitute for any single one of the keepers **24**, **24'**, or clasp **28** shown in the specification of the present application, much less all of them. Assuming that the clip **92** could be inserted through a pierced body part, which Applicants are not aware has ever been done, the bead is simply too small to retain the clip **92** in the body part. Applicants note that in order to insert the clip **92** through a pierced body part, the bead at the free end of the clip **92** would have to be pushed through the pierced opening, thereby widening the opening enough for the bead to slip back out, whereas keepers **24**, **24'**, are not passed through the pierced opening, but rather the free end of the post is. For these additional reasons, the Yu patent does not show the attachment means of Claims 1 and 11, and is deficient as a 35 U.S.C. § 102 (b) reference.

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With respect to the rejection of independent Claims 1 and 11 under 35 U.S.C. § 103 (a) as being unpatentable under Miceli in view of Gong-Hwa, the Examiner asserts that the Miceli patent shows all of the elements of Claims 1 and 11 except for the “vibrating motor unit.” The Examiner further asserts that the Gong-Hwa patent discloses “...a vibrating motor unit 35 (the buzzer vibrates)...”, and that it would be obvious to one of ordinary skill in the art to modify the Miceli invention to include the “vibrating motor unit” disclosed by Gong-Hwa. Applicants respectfully traverse this rejection for two reasons.

First, Applicants respectfully submit that the Gong-Hwa patent does not disclose a vibrating motor unit within the meaning of Claims 1 and 11 of the present Application. The present Application claims a vibrating body jewelry item. The vibrating motor unit imparts sufficient vibration to the post, keeper and housing that the vibration is palpable by the wearer in order to stimulate the body tissues of the body part to which the vibrating body jewelry is attached. A vibrating motor is a well known term in the electronics art. The meaning of the term usually conveys a rotating shaft having an eccentrically weighted disc or other eccentrically mounted weight attached to the shaft in order to produce vibration. See, for example, the Klein patent (U.S. Patent No. 6,419,649, relied upon by the Examiner in the previous Office Actions), at col. 3, lines 41-44 (a vibrator motor that generates vibration by spinning an unbalanced weight attached to the motor shaft).

The Gong-Hwa patent discloses a ring having a plurality of light emitting diodes (LEDs) mounted behind a translucent gemstone, and also a sound producing circuit. The sound producing circuit includes a buzzer 35 and an integrated circuit programmed to cause the buzzer to play a pre-stored musical signal.

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The ring base has a plurality of holes **15** defined therein to allow the sound waves to exit the housing. The device is operated by pressing a cap **20**, causing the LEDs to emit light through the gemstone, and the buzzer to produce the pre-stored musical signal. Gong-Hwa does not describe the buzzer as producing vibrations, nor the internal structure of the buzzer **35**.

Applicants respectfully submit that a buzzer is not a vibrating motor unit. Buzzers are usually of two types. One type has a coil with a powdered iron core forming an electromagnet with a flexible armature disposed in cantilever fashion above the core, so that when an alternating current is applied to the coil, the alternating magnetic fields cause the armature to vibrate against the core, producing a buzzing sound. The second type, and the type probably used in the Gong-Hwa device, is a piezoelectric buzzer, having a crystal with a disk attached thereto disposed in a Helmholtz chamber with a hole for release of the sound waves at the end of the chamber. An oscillating current produced by a multivibrator or the like causes mechanical stress in the crystal, causing the disk to oscillate at the resonant frequency of the Helmholtz chamber, producing a buzzing noise. Neither device is considered a motor by those skilled in the electronics arts. Further, neither device, particularly the piezoelectric device, is known to produce sufficient vibration to produce a palpable vibration effect. In the Gong-Hwa patent, the buzzer is not used to cause the wearer of the ring to feel vibration, but merely to produce sound.

Applicant is mindful that, pursuant to MPEP 2111, the Examiner gives the terms of a claim their broadest possible interpretation. However, MPEP 2111 also limits that broadest possible interpretation to one consistent with the specification. The specification of the present Application describes a vibrating

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or vibratory motor unit which imparts vibration to body jewelry. The Gong-Hwa patent describes a buzzer which produces sound, and it is unlikely to produce vibrations which have any palpable effect. Consequently, Miceli in view of Gong-Hwa does not show all of the elements of Claims 1 and 11, and are deficient as 35 U.S.C. § 103(a) references.

Furthermore, Applicants note that obviousness cannot be shown by combining the teachings of the prior art unless there is some teaching or incentive supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984); *In re Geiger*, 815 F.2d at 688, 2 USPQ2d at 1278 (Fed. Cir. 1987). Further, the Federal Circuit in *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999) deprecated rejections based upon "a hindsight-based obviousness analysis" and emphasized that what is required is a "rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references." The Court said that "the showing must be clear and particular" and that broad conclusory statements regarding the teaching of multiple references and "a mere discussion of the ways that the multiple prior art references can be combined to read on the claimed invention" is inadequate. Absent an explicit suggestion or teaching of the combination in the prior art references, there must be "specific...findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis".

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As this court has stated, "virtually all [inventions] are combinations of old elements." (*citations omitted*). ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." *Sensoronics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed. (*Emphasis added*).

In re Rouffet, 47 USPQ2d 1453 (Fed. Cir. 1998) at 1457-58.

Furthermore, references cannot be combined if the combination would destroy the purpose or object of the reference, or render the prior art device being modified unsatisfactory for its intended purpose.. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984), discussed in MPEP 2143.01.

The purpose of the Miceli invention is to provide an electrical earring having an LED which transmits light through a fiber optic post to be transmitted through a natural or synthetic gemstone when the post is inserted through the earlobe and the two sections of the earring are connected (column 1, lines 34-58). There is no explicit or implicit suggestion in Miceli that a vibratory motor unit or a buzzer may be

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incorporated into the earring. The purpose of the Gong-Hwa invention is to provide a ring which produces sound and lighting effects when depressed, and which is inexpensive (col. 1, lines 23-26). There is no explicit or implicit suggestion in Gong-Hwa that the light and sound producing mechanisms could be incorporated into an earring.

Further, the electrical earring described by Miceli is designed to be on at all times when worn on the earlobe (col. 4, lines 1-19; the post is inserted through the earlobe so that the washer lies against the earlobe, compressing the spring and energizing the LED; the mounting body with the gemstone is then secured to the other end of the post). This is consistent with the purpose of the Miceli invention, since it causes the earring to be perpetually illuminated in accordance with its ornamental appearance. If the buzzer of Gong-Hwa is combined with the electrical earring of Miceli, Applicants respectfully submit that the purpose of the Miceli invention would be destroyed, since the buzzer would always be on, causing the wearer to experience a constant buzzing noise right on the wearer's earlobe. If the switch mechanism of Gong-Hwa is also combined with the Miceli invention, the purpose is still destroyed, since (1) the fiber optic LED will not illuminate the earring constantly, but only when depressed; and (2) in order to depress the switch when incorporated into an earring, more than likely the wearer's fingers will be disposed over the gemstone, thereby concealing the fiber optic illumination which is the purpose of the Miceli invention. Furthermore, the portion of the earring designed to house the battery and LED is specifically designed to accommodate the fiber optic post, and does not define a Helmholtz chamber probably required for the Gong-Hwa buzzer, and there are no holes in the Miceli earring housing for emitting the sound produced

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by the buzzer, so that various modifications would have to be made to the Miceli earring to accommodate the buzzer, the scope of which are not clear. It is further likely that palpable vibration produced on the earlobe by a buzzer, if any, would be *de minimis* as compared to the vibratory motor unit of the present invention.

As for combining the post structure of the Miceli invention with the ring of Gong-Hwa, there is very little motivation for doing so, since the Gong-Hwa ring is designed to be an inexpensive novelty item, the electrical illumination and sound only being produced when the cap is depressed. Further, it is not entirely clear how one skilled in the art would incorporate a fiber optic post for an earring into a ring worn on the finger.

Since (1) the claim term "vibrating motor unit" is not so broad that it encompasses a buzzer; (2) there is no suggestion or motivation to combine the teachings of Gong-Hwa with Miceli; and (3) incorporating the buzzer of the Gong-Hwa invention into the electrical earring of Miceli would destroy the intended purpose of the Miceli invention, if feasible, which may not be a technically obvious procedure to one skilled in the art, Applicants respectfully submits that independent Claims 1 and 11 are not unpatentable over Miceli in view of Gong-Hwa under the provisions of 35 U.S.C. § 103(a).

With respect to the rejection of independent Claim 15 under 35 U.S.C. § 103(a) over Miceli in view of Gong-Hwa and further in view of Erickson, Applicants traverse the rejection for the same reasons recited above. The rejection is based upon the same grounds, with the addition of the Erickson reference to show a threaded recess in a housing and a threaded end on a post. It is unnecessary to address this

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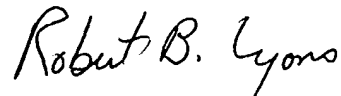
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issue, since the Gong-Hwa patent is deficient as a reference to show a vibratory motor unit for the reasons discussed above.

Consequently, Applicants respectfully submit that independent Claims 1, 11, and 15, and corresponding dependent Claims 2-10, 12-14, and 16-20, respectively, are allowable over the prior art of record.

For the foregoing reasons, Applicant respectfully submits that the present application is in condition for allowance. If such is not the case, the Examiner is requested to kindly contact the undersigned in an effort to satisfactorily conclude the prosecution of this application.

Respectfully submitted,



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